

## REMARKS

Claims 1 and 30 have been amended and no claims have been canceled in this paper. Hard carriage or paragraph returns have been added to claims 1 and 30 for easier reading wherein the original claims were formatted as a single paragraph, and “travelled” has been changed to “traveled” in claim 30. Applicants ask the examiner to kindly enter this amendment, and after entry on the record, claims 1, 2, 7-10, 15, 18, 22, 24-31, 36-39, 44, 47, 51, and 53-58 will be pending in the application.

Applicants have carefully reviewed the arguments presented in the final Office Action and respectfully request reconsideration of the claims in view of the remarks below.

### Rejections under 35 U.S.C. § 103

The examiner rejected claims 1-2, 7-9, 15, 18, 22, 24-27, 29-31, 36-38, 44, 47, 51, 53-56, and 58 under 35 U.S.C. § 103(a) over U.S. Patent No. 4,320,292 (Oikawa et al.) in view of PCT International Publication No. WO 03/104965 (Lipman et al.). The examiner rejected claims 10, 28, 39, and 57 under 35 U.S.C. § 103(a) over Oikawa in view of Lipman and further in view of AAPA. These rejections are respectfully traversed.

According to the examiner on page 2 of the current Office Action, Oikawa teaches an interface apparatus with “a panel defining at least one edge (Figs. 1, 2 and 6-11).” Applicants note, however, that the panel used in Oikawa is highly specialized with “optical guide channels.” Oikawa explains that “[t]he light emitted by the light pen 10 is scattered by optical scatterer contained in the optical guide channels 11 and 12, and the scattered light propagates through these channels to reach the end surfaces 11a and 12a confronting the photo detectors 13 and 14 respectively.” (Oikawa, column 3, lines 28-33.) Oikawa further emphasizes that “[t]he scatterer which **plays an important role** in the optical guide channels of this invention should satisfy the following conditions ....” (Oikawa, column 5, lines 52-68). In one example, the Oikawa scatterer is a fine powder

less than 1/10 of the wavelength and having “0.025% by weight of a fine powder of silica having a grain diameter of several tens of angstroms.” (Oikawa, column 6, lines 15-17.)

The present invention panel does not require specialized optical guide channels and/or scattering particles. To better define the present invention over the art, applicants have amended claim 1 to provide “a panel without an optical guide and scattering particles therein defining at least one edge.” Indeed, applicants’ specification provides that the “[p]anel 100 may be made of any suitable material, and is typically formed of a glass or plastic substrate, such as Plexiglass and need not necessarily be rigid. Alternatively, a transparent non-scattering element in contact with a Lambertian surface may be employed.” (Applicants’ specification, page 18, lines 26-28.) There is no mention of any need for special optical guide channels and embedded scattering particles, and a transparent *non-scattering* element may be used in an alternative embodiment. Independent claim 30 has been similarly amended. At least for this reason, the rejected claims are not obvious in view of Oikawa.

The examiner attempts to combine Oikawa with Lipman WO 03/104965. Applicants believe the combination is improper.

As noted above, Oikawa clearly states that the scatterer (fine powder of silica) embedded in the optical guide channels “plays an important role” in the invention. Lipman does not require or teach use of special optical guide channels with embedded scatterer, so by combining Oikawa with Lipman, the examiner is modifying the Oikawa display to omit the optical guides with scatterer, which is clearly contrary to what the Oikawa device requires. The examiner’s proposed modification will render the Oikawa device unsatisfactory for its intended purpose. Under MPEP 2143.01 V: “If [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.”

If the examiner modifies Lipman to include optical guides and scatterer, then it is unpredictable whether this modified device will function at all. It is unknown what detrimental effect the scatterer will have on the Lipman panel, for example. Under MPEP 2143.02 II: “Obviousness does not require absolute predictability, however, at least some degree of predictability is required. Evidence showing there was no reasonable expectation of success may support a conclusion of nonobviousness.”

At least for the above reasons, applicants respectfully contend that the two cited references cannot be properly combined, and indeed there is no motivation for them to be combined. Without this combination, the 103 obviousness rejections must fall as the amended claims are patentable over Oikawa alone.

In view of the foregoing, applicants respectfully submit that all claims are in condition for allowance. Reexamination and reconsideration are respectfully requested and allowance at an early date solicited. Applicants respectfully do not agree with the examiner on the grounds supporting the other rejections not specifically addressed above. Further, applicants have reviewed the prior art made of record but not relied upon, and respectfully submit that the art does not teach or suggest the present invention.

The Commissioner is authorized to charge Deposit Account No. 06-2426 for any unforeseen fees arising in connection with the filing of this paper. Applicants further invite the examiner to contact the undersigned for any questions arising from this reply.

Respectfully submitted,

FULWIDER PATTON LLP

By: /Paul Y. Feng/  
Paul Y. Feng  
Registration No. 35,510

Howard Hughes Center  
6060 Center Drive, Tenth Floor  
Los Angeles, CA 90045  
Telephone: (310) 824-5555  
Facsimile: (310) 824-9696  
Customer No. 24201  
404763.1